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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/903,508	07/13/2001	Charles Abbas	1533.0830003/MAC/RGM	3856

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EXAMINER

LAMBERTSON, DAVID A

ART UNIT	PAPER NUMBER
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1636

DATE MAILED: 05/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/903,508

Applicant(s)

ABBAS ET AL.

Examiner

David A. Lambertson

Art Unit

1636

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 12 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 1-18,20 and 21.

Claim(s) objected to: _____.

Claim(s) rejected: 19.

Claim(s) withdrawn from consideration: 22-31.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☒ Other: See Continuation Sheet

JAMES KETTER
PRIMARY EXAMINER

Continuation of 3. Applicant's reply has overcome the following rejection(s): The rejection of claims 1,3,6,13 and 20 under 35 USC § 112, first paragraph, Written Description; the rejection of claims 15-19 under 35 USC § 112, first paragraph, enablement; the objection of claims 1-14, 20 and 21 as containing non-elected subject matter.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments fail to overcome the rejection under 35 USC § 112, first paragraph, New Matter. Applicant suggests that several paragraphs provide explicit support for the range of sucrose concentrations (0.3 M to 1.0 M) indicated as a limitation in claim 19. These paragraphs are [0269], [0298], and [0492].

First, it is noted that the paragraph [0492] is not even a paragraph in the instant specification; the final paragraph is [0484]. Thus, there can be no support for the aforementioned range in this paragraph.

Second, paragraph [0269] talks about the transformation frequency using a particular protocol. In this protocol, only a solution of 1 M sucrose is used (see paragraph [0268]). The fact that the cells were plated on media containing 0.3 M sucrose is not equivalent to electroporating cells in a 0.3 M solution of sucrose. Even if it were, this does not lend support to the specific range set forth in the limitation, only the use of two independent sucrose concentrations. Thus, there can be no support for the aforementioned range in this paragraph.

Third, paragraph [0298] again talks about transformation frequencies; however, there is no indication of a range of concentrations (or even an individual concentration) of sucrose solutions to be used in the protocol anywhere in the example in which paragraph [0298] resides. Thus, there can be no support for the aforementioned range in this paragraph.

In conclusion, it was previously set forth that Applicant had no explicit or implicit support for the range of concentrations of sucrose solutions to be used in the electroporation of cells, as set forth in claim 19. Therefore this range of limitations represents new matter. Applicant has provided paragraph numbers where alleged support for this limitation can be found. However, a review of these paragraphs (and their related paragraphs) shows no such evidence. In combination with the Office's own review of the application, it is still determined that there is no support for the limitation of 0.3 M to 1.0 M sucrose solution, as set forth in claim 19. As such, the claim remains rejected.

Continuation of 10. Other: applicant is reminded that claims 22-31 are withdrawn from consideration, and must be cancelled in order to place the case in condition for allowance.